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10/544,096	08/01/2005	Theresia Rieser	03/014 K	7764

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PROPAT, L.L.C.
425-C SOUTH SHARON AMITY ROAD
CHARLOTTE, NC 28211-2841

EXAMINER	
WOMACK, DOMINIQUE A	
ART UNIT	PAPER NUMBER
4132	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/544,096	RIESER ET AL.	
	Examiner	Art Unit	
	DOMINIQUE WOMACK	4132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/01/2005 (Prelim Amend)*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) *13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 14-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20050801 (two)*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-12 and 14-16, drawn to a food casing.

Group 2, claim(s) 13, drawn to a method for producing a food casing.

2. The inventions listed as Groups 1 and 2 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The common technical feature of Groups I and II appears to be a casing.

3. Claim 1 of Group I is not novel with respect to US Pat No. 4,933,217 to Chiu. Chiu discloses a cellulose casing, impregnated with smoke aroma, that has an L* value of 53.30 before impregnation. The casing is then stuffed with a sausage stuffing and after a period of time the casing was removed from the stuffing. The L* value of the casing after removal from the stuffing was 50.62 (Table 2 & col. 16 line 59- col. 17 line 18). In addition, the presently claimed property of the L* value decreasing by no more than 5 before stuffing would obviously have been present, absent evidence or argument to the contrary, because the overall decrease of the L* value is less than 5.

4. Therefore, there is no special corresponding technical feature among the claim groups of the claimed invention because the corresponding technical feature is not found to define a contribution over the prior art. Furthermore, there is a lack of unity of invention and a restriction requirement is proper.

5. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

6. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double

patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

7. During a telephone conversation with Attorney Cathy More on January 8, 2009 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-12 and 14-16. Affirmation of this election must be made by applicant in replying to this Office action. Claim 13 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

8. It is noted that the crossed-out reference in the Information Disclosure Statement filed on 8/01/2005 is not indicated as being considered because it is a duplicate of an entry that has already been indicated as being considered.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 3, 6, 8, and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Regarding claim 3, the limitation "wherein the L* value, after removal from the food, has decreased by 0.1 to 3" is unclear. It is unclear whether this decrease is in regards to the L* value

before impregnation or after impregnation but before stuffing. For the purposes of examination, the decrease will be interpreted to be in relation to the L* value before impregnation.

12. Regarding claim 6, the limitation "wherein the change of the a* and b*value, after removal from the food, is no more than ±3" is unclear. It is unclear whether this change is in regards to the a* and b*value before impregnation or after impregnation but before stuffing. For the purposes of examination, the change will be interpreted to be in relation to the a* and b*value before impregnation.

13. Claim 8 recites the limitation "fibrous reinforcement" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 1, from which claim 8 depends, does not refer to a food casing comprising a fibrous reinforcement.

14. Regarding claim 12, the limitation "wherein it is finally processed" is unclear. It is unclear what conditions are necessary for the claimed casing to be "finally processed".

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1-4, 7, 10-12 and 14-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chiu [US Pat No. 4,933,217].

17. Regarding claim 1, Chiu discloses a regenerated cellulose casing, impregnated with smoke aroma, that has an L* value of 53.30 before impregnation. The casing is then stuffed with food and after a period of time the casing was removed from the stuffing. The L* value of the casing after removal from the stuffing was 50.62 (Table 2 & col. 16 line 59- col. 17 line 18).

18. In addition, the presently claimed property of the L* value decreasing by no more than 5 before stuffing would be expected to be present, absent evidence or argument to the contrary, because the overall decrease of the L* value is less than 5. The food casing of Chiu is comprised of the same material and structure and the claimed property is believed to be inherently present. Therefore, burden shifts to the applicant to demonstrate otherwise patentable difference. Note In re Best, 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

19. Regarding claim 2, the presently claimed property of the L* value decreasing to a value between 0.1 and 2 before stuffing would be expected to be present, absent evidence or argument to the contrary, because the overall decrease of the L* value is between 0.1 and 2. The food casing of Chiu is comprised of the same material and structure and the claimed property is believed to be inherently present. Therefore, burden shifts to the applicant to demonstrate otherwise patentable difference. Note In re Best, 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

20. Regarding claim 3, the L* value disclosed in Chiu decreased by 2.68 (calculation: 53.30-50.62=2.68).

21. Regarding claim 4, the presently claimed property of the a* value changing by ±5 before stuffing would be expected to be present, absent evidence or argument to the contrary, because the overall change of the a* value is +1.6. Therefore, burden shifts to the applicant to demonstrate otherwise patentable difference. The food casing of Chiu is comprised of the same material and structure and the claimed property is believed to be inherently present. Note In re Best, 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

22. Regarding claim 7, Chiu discloses that tubular cellulosic casings can have a fibrous reinforcing web embedded in the wall thereof (col. 4, lines 55-60).

23. Regarding claim 10, Chiu discloses that a polyamide epichlorohydrin resin may be internally coated on the internal surface of a casing treated with liquid smoke to improve the adhesion to the food products processed therein (col. 10, lines 8-17).

24. Regarding claim 11, Chiu discloses that agents for improving the peelability of food casings may be optionally coated on the internal surface of the casings before or after the external liquid smoke treatment step (col. 8, lines 53-58).

25. Regarding claim 12, Chiu discloses that the food casing can go through a shirring step after impregnation (col. 7 lines 7-23).

26. Regarding claim 14, Chiu discloses that the regenerated cellulose food casing can be used as a sausage casing (col. 8, lines 1-5).

27. Regarding claim 15, Chiu discloses that the sausage casing is passed into a drying chamber wherein it is dried (col. 8, lines 22-26).

28. Regarding claim 16, Chiu discloses that the food casing is generally provided in the form of shirred casing sticks (col. 11, lines 26-27).

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

30. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

31. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

32. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chiu [US Pat No. 4,933,217] in view of Nicholson [US Statutory Invention Registration H1592].

33. Chiu is relied upon as above with respect to claim 1.

34. Chiu discloses a* values of an impregnated cellulose casing before impregnation and after impregnation and removal from food. The a* value before impregnation is 15.06 and the a* value after impregnation and removal from food is 16.66, a difference of +1.6 (Table 2).

35. Chiu fails to disclose the b* values of the food casing.

36. Nicholson discloses b* values for a impregnated cellulose casing before impregnation and after impregnation and removal from food (Table VIII). The b* value before impregnation is 15.39 (NoJ. Clear) and the b* value after impregnation and removal from food is 16.77 (NoJ. Smoke), a difference of +1.38 (Table VIII). These b* values were obtained by treating the casings with liquid smoke by dipping the casings for 3 minutes into a 10 mixture of 60% smoke, 34% water, and 6% glycerin.

37. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to control and measure the b* value of the food casing of Chiu by controlling the application of liquid smoke in order to provide a food casing with specific color characteristics. One of ordinary skill in the art would be motivated to provide a food casing with specific color characteristics because Chiu discloses that liquid smoke is applied to a casing for an amount of

time sufficient for the casing to pick up an adequate amount of smoke coloring and flavoring (col. 7, lines 7-23).

38. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chiu [US Pat No. 4,933,217] in view of Hansen et al. [US Pat No. 4,889,751].

39. Chiu is relied upon as above with respect to claim 1.

40. Chiu fails to disclose that the fibrous reinforcement is a fibrous paper.

41. Hansen et al. disclose that tubular cellulosic casings may have fibrous paper reinforcement in the casing wall to provide dimensional stability (col. 1, lines 65-69).

42. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to include the fibrous paper of Hansen et al. as the fibrous reinforcement of Chui in order to provide a fibrous food casing. One of ordinary skill in the art would be motivated to provide a fibrous food casing comprising fibrous paper because Hansen et al. show that fibrous paper reinforcement provides dimensional stability.

43. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chiu [US Pat No. 4,933,217] in view of Quinones et al. [US Pat No 6,045,848].

44. Chiu is relied upon as above with respect to claim 1.

45. Chiu fails to disclose that the food casing is a white, cream-colored or chamois-colored casing having an L* value of more than 80.

46. Quinones et al. disclose a food casing that has a L* value greater than 80 (Table A, Example 1). Quinones et al. disclose that this casing may be treated with tar-containing or tar depleted liquid smokes (col. 8, lines 5-8).

47. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to use a lighter colored casing for the product of Chiu in order to produce a impregnated cellulose casing that has a L* value of 80 or more before impregnation. One of ordinary skill in the art would be motivated to produce a impregnated cellulose casing that has a L* value of 80 or more before impregnation because Quinones et al. show that this type of casing is suitable for liquid smoke application.

Conclusion

48. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOMINIQUE WOMACK whose telephone number is (571)270-7366. The examiner can normally be reached on Monday-Thursday, 8:00am-5:00pm.

49. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike LaVilla can be reached on 571-272-1539. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

50. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. W./
Dominique Womack
Examiner, Art Unit 4132

13 January 2009

/Michael La Villa/
Michael La Villa
Supervisory Patent Examiner, Art Unit 4132
20 January 2009